

REMARKS

Claims 1, 3-10, and 12-14 are pending in this application.

Applicant has amended claims 1, 3-6, 10, 13, and 14, and has canceled claims 2 and 11. The changes to the claims made herein do not introduce any new matter.

Rejection Under 35 U.S.C. § 102

Applicant respectfully requests reconsideration of the rejection of claims 1-3, 5, and 7-14 under 35 U.S.C. § 102(b) as being anticipated by *Hagstrom et al.* (“*Hagstrom*”) (US 5,927,208) (as noted above, claims 2 and 11 have been canceled). As will be explained in more detail below, the *Hagstrom* reference does not disclose each and every feature specified in independent claims 1, 10, 13, and 14, as amended herein.

The *Hagstrom* reference relates to a printer for printing labels on compact discs (CDs). In particular, the *Hagstrom* reference discloses a calibration technique for ensuring that the label is properly positioned when printed. In the calibration technique shown by *Hagstrom*, a first printing that includes a series of radially spaced lines is printed on a calibration medium. The calibration medium is then rotated by 180 degrees, and a second printing that includes sets of spaced lines and numerals is printed on the calibration medium. When some of the lines of the first printing align with those of the second printing, the number at which they align is input into a printer to carry out the calibration. As such, the calibration technique of *Hagstrom* involves the printing of two different sets of lines.

On the other hand, in the claimed subject matter, a base line is previously printed at a precise location. As such, the claimed configuration need only print a single marker on an adjustment medium. Thus, the claimed subject matter is significantly different from the calibration technique shown in the *Hagstrom* reference.

Turning now to the claims, Applicant has amended independent claim 1 to include the features of original claim 2. In particular, claim 1 has been amended to specify that one of the

base line and the marker is a circle on the adjustment medium, and that the other of the base line and the marker includes scale marks arranged at predetermined intervals on at least two axes that are directed from a center of the adjustment medium to a circumference of the adjustment medium and differ in direction. In light of the changes to claim 1, claim 2 has been canceled.

In support of the anticipation of rejection of claim 2 in the Office Action, the Examiner asserts that Figure 4 of *Hagstrom* shows a circle as one of the base line and the marker. The circle shown in Figure 4, however, is merely a CD, and thus is different from a “circle” as a base line or a marker. Accordingly, for at least this reason, *Hagstrom* does not disclose each and every feature of the subject matter defined in present claim 1.

Further, *Hagstrom* prints two sets of scale marks from different directions. Consequently, during operation, the user needs to manually rotate the adjustment medium 180° (see column 4, lines 43-46). In the claimed subject matter, the adjustment medium has a circle or scale marks previously printed thereon as a base line. As such, the claimed configuration only has to print a single set of scale marks or a single circle as a marker to carry out calibration.

Applicant has amended each of independent claims 10, 13, and 14 along the same lines that claim 1 has been amended (in light of the changes to claim 10, claim 11 has been canceled). As such, the arguments set forth above regarding present claim 1 also apply to present claims 10, 13, and 14.

Accordingly, independent claims 1, 10, 13, and 14, as amended herein, are patentable under 35 U.S.C. § 102(b) over *Hagstrom*. Claims 3, 5, and 7-9, each of which depends from claim 1, and claim 12, which depends from claim 10, are likewise patentable under 35 U.S.C. § 102(b) over *Hagstrom* for at least the reason that these claims depend from either claim 1 or claim 10.

Rejection Under 35 U.S.C. § 103

Applicant respectfully requests reconsideration of the rejection of claims 4 and 6 under 35 U.S.C. § 103(a) as being unpatentable over *Hagstrom* in view of *Matsuoka et al.* (“*Matsuoka*”) (US 5,337,668). Claim 4 ultimately depends from claim 1, and Applicant has rewritten claim 6 in independent form.

Applicant has amended claim 4 along the lines suggested by the Examiner. Thus, as acknowledged by the Examiner (see the Office Action at page 7), the combination of *Hagstrom* in view of *Matsuoka* would not have rendered the subject matter defined in present claim 4 obvious to one having ordinary skill in the art. Further, the *Matsuoka* reference does not cure the deficiencies of the *Hagstrom* reference relative to the subject matter defined in present claim 1, from which claim 4 ultimately depends.

As noted above, Applicant has rewritten claim 6 in independent form. In the course of so doing, Applicant has amended claim 6 along the lines suggested by the Examiner. Thus, as acknowledged by the Examiner (see the Office Action at page 8), the combination of *Hagstrom* in view of *Matsuoka* would not have rendered the subject matter defined in present claim 6 obvious to one having ordinary skill in the art.

Accordingly, in view of the foregoing, claims 4 and 6, as amended herein, are patentable under 35 U.S.C. § 103(a) over the combination of *Hagstrom* in view of *Matsuoka*.

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of claims 1, 3-10, and 12-14, as amended herein, and submits that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in

Application No. 10/668,450
Amendment dated July 6, 2009
Response to Office Action mailed April 6, 2009

connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP055).

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, L.L.P.

/Peter B. Martine/

Peter B. Martine
Reg. No. 32,043

710 Lakeway Drive, Suite 200
Sunnyvale, California 94085
Customer Number 25920